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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,918	07/03/2003	Takashi Igarashi	108833.01	5605

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EXAMINER

SHAKERI, HADI

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,918

Applicant(s)

IGARASHI ET AL.

Examiner

Hadi Shakeri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 4 are presented as method claims, but, the form does not conform to the US standard and practice, i.e., a method claim should recite the steps in the method, whereas here, the preamble recites a method of machining using a spectacle lens machining apparatus "comprising" a machine having structural limitations, and further recites "...wherein the method "comprises", when the groove..." rendering the scope unascertainable, for making it unclear whether the structures recited for the apparatus is part of the method claim or not. A method claim should recite steps, Applicant may wish to amend by reciting a positive step for the apparatus, e.g., "A spectacle lens machining method...comprising: providing a spectacle lens machining apparatus including..." and then recite the further steps of the method.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

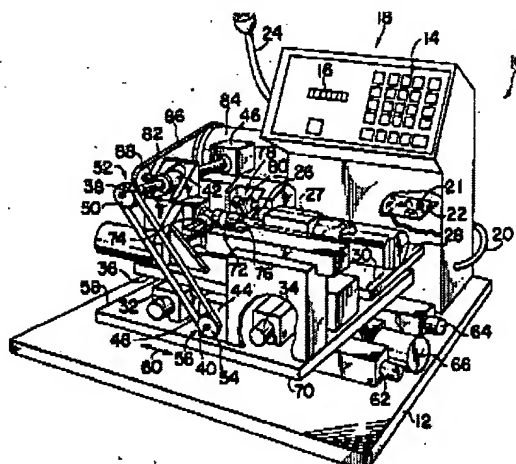
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Woods, US Patent No. 5,053,971.

Woods discloses all the limitations of the above claims, i.e., a lens apparatus and machining method with a lens holding unit holding the lens at a center part by a shaft (128), a circumferential surface edging unit a groove machining unit and a lens shape measurement unit, it discloses a cutter including plurality of cutting portions for chamfering or pin beveling the lens corners.



Wherein the proper speed and feed rate are set based on the material selected, col. 10, line 28, and rotating the chuck in accordance with one or more operations, col. 1, lines 45-53, and wherein the thickness is determined and utilized in the instruction set in the program, col. 4, lines 45-55.

Wherein the method includes the steps of detecting the displacement of a probe (74) in the direction of the thickness and calculating other positions, or mapping the surface of the lens and a step of edging, col. 4, lines 17-56, and further steps of beveling, grooving and chamfering.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. in view of Mizuno et al., US Patent No. 6,074,280.

Wood et al meets all the limitations of the above, except for specifically disclosing setting the speed based on rough machining or fine machining. Mizuno et al. teaches setting the speed in reference to the material used or the input processing condition, and different speed for rough or fine finishing (mirror-finish). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of Woods et al. by setting the speed by input process condition, e.g., the type of machining as taught by Mizuno et al. for an enhanced lens grinding, which can shorten the processing time and improve the quality, Mizuno et al., col. 1, lines 55-61.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

6. Applicant's arguments filed 08/16/04 have been fully considered but they are not persuasive. The argument that Wood does not disclose setting machining condition according to a lens thickness and a lens material, and that the machining conditions including a turning speed of the lens holding shaft and/or the tool are not set accordingly, is not persuasive since

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Wood discloses on 01:54-59, that mapping information which includes thickness measurement, is used to determine and locate the bevel location and placement to detect unusual problems such as lens blank being too small, "too thin" to "too thick", it further discloses, e.g., on 04:46-52, that the controller utilizes these information and again on 10:35-50, discloses that the distance back from the front face is controlled based on local thickness thus meeting the limitation of setting the conditions according to a lens thickness. Wood further discloses, e.g., on 10:25-29, that the lens edging apparatus will automatically set up the proper speed and feed rate for the material selected, meeting the other parts of the limitations as recited. The argument regarding "chamfering" is not persuasive as evident by, e.g., claim 10 of Wood.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The teaching from Mizuno et al. is to set different speed for different processing conditions, e.g., material selected, fine finishing and rough finishing. Even though this teaching is considered to be well within the knowledge of one of ordinary skill in the art, Mizuno was utilized, which clearly indicate, e.g., in the Abstract, that the rotational speed of the tool is based on the material used, or "a process condition" of the lens. It further defines the process conditions, e.g., 03:12, to include "mirror-finishing" or not, on 07:52, i.e., "rough finishing".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is (571) 272-4495. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail, III can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Hadi Shakeri', with a stylized flourish at the end.

Hadi Shakeri
Primary Examiner
Art Unit 3723
November 23, 2004